

## **REMARKS/ARGUMENTS**

### **1. Examiner's Response to Applicants' Prior Arguments**

In response to the prior office action, the Applicants 1) amended claim 8 to include the subject matter of claim 9, which had been rejected as obvious over Chuah (U.S. Patent Publication No. 2004/0032877; "Chuah I") in view of Willekes (U.S. Patent Publication No.2002/0075824) and Chuah (U.S. Patent No. 6,674,765; "Chuah II"), and 2) submitted arguments traversing the substantive basis of rejection. In the present office action, the Examiner responds to Applicants' arguments by asserting that the claim amendment "necessitate[d] a new search and a new ground of rejection." The Examiner, however, **only** relies on the same exact prior art references for rejecting claim 8 as amended to include the subject matter of claim 9. Similarly, the Applicants amended claim 10 to include the subject matter of claim 11, both of which the Examiner had rejected as obvious over Chuah II in view of Willekes. Again, in the present office action, the Examiner **only** relies on the same exact prior art references for rejecting claim 10 as amended to include the subject matter of claim 11. The Applicants, therefore, assert that the finality of the office action was premature and, for the reasons that follow, respectfully request that the bases of rejection be reconsidered.

### **2. Claim Rejections – 35 U.S.C. §103(a)**

The Examiner rejected claims 8 and 13-14 as being unpatentable over Chuah (U.S. Patent Publication No. 2004/0032877; "Chuah I") in view of Willekes (U.S. Patent Publication No.2002/0075824) and Chuah (U.S. Patent No. 6,674,765; "Chuah II"); claim 10 as being unpatentable over Chuah II in view of Willekes; and claim 12 as being unpatentable over Chuah I in view of Willekes, Chuah II and Osawa, (U.S. Patent No. 5,621,732). The Applicants, again, traverse the rejections.

In rejecting claim 8, the Examiner acknowledges that Chuah I and Willekes fail to teach selecting a preamble signature for use on a sub-channel of a random access channel for subscribing user equipments. To overcome that deficiency, the Examiner looks to the teachings of Chuah II, asserting that it teaches:

"selecting a preamble signature for use on a sub-channel of a random access channel for the subscribing user equipments (Chuah, USPN 6,674,765, Fig. 8, Element 804, Col. 12, Lines 37-50, Chuah ('765) directed toward use of a sub-channel of a random access channel, see Col 6, Lines 55-67)"

The undersigned has reviewed the referenced portions of Chuah II, however, and do not see what the Examiner asserts is taught at the referenced locations. Although element 804 in Figure 8 illustrates and is described as a step of selecting a preamble, there is no teaching at column 6, lines 55-67, of selecting a preamble signature "for use on a sub-channel of a random access channel for subscribing user equipments," as recited in claim 8. Therefore, the Examiner has not established a *prima facie* case of obviousness for that claim. Thus, whereas claims 12-14 are dependent from claim 8, and include the limitations thereof, they are also not obvious in view of Chuah I, Willekes and Chuah II.

In maintaining the rejection of claim 10, which was amended to include the subject matter of claim 11, the Examiner still relies on the combination of Chuah II and Willekes. As established *supra* with respect to claim 8, however, there is no teaching at column 6, lines 55-67, in Chuah II of selecting a preamble signature "for use on a sub-channel of a random access channel for subscribing user equipments," as recited in claim 10. Therefore, the Examiner has not established a *prima facie* case of obviousness for claim 10 in view of Chuah II and Willekes.

\* \* \*

**CONCLUSION**

From the foregoing, it can be seen that the Examiner has again not established how Chuah II teaches the specific elements of claims 9 and 11 as incorporated into claims 8 and 10, respectively. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 8, 10 and 12-14.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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